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UNITED STATES DISTRICT COURT

IN AND FOR THE NORTHERN DISTRICT OF CALIFORNIA

RICHARD W. BERGER and
BRANT W. BERGER

Plaintiffs,

v.

ROSSIGNOL SKI COMPANY, INC.

Defendant.

Case No. 3:05-CV-02523 CRB

**PLAINTIFFS' NOTICE OF MOTION
AND MOTION TO DEFER SUMMARY
JUDGMENT MOTION LOCAL RULES
6, 7, 56, F.R.C.P. 56(f)**

NO HEARING REQUESTED

Date: March 31, 2006

Time: 10:00 a.m.

Judge: Charles R. Breyer

Dept.: Courtroom 8, 19th Floor

Plaintiff moves to put over the summary judgment motion filed by defendant Rossignol
Ski Company, Inc. ("Rossignol") until after the claim construction hearing herein.

1 **MEMORANDUM OF POINTS AND AUTHORITIES:**

2 Local Patent Rule 1-2 provides in pertinent part “if any motion filed prior to the claim
3 construction hearing provided for in Patent L.R. 4-6 raises claim construction issues, the Court
4 may, for good cause showing, defer the motion until after the completion of the disclosures,
5 filings or rulings following the claim construction hearing. . . .”

6 Rossignol filed a motion for summary judgment on the basis of (1) equitable estoppel; (2)
7 non-infringement and (3) invalidity.

8 This case is in its very early stages and plaintiff has not yet undertaken discovery.

9 Under the local rules, a claim construction hearing would not be held for several months.
10 The parties have yet to exchange preliminary claim constructions, complete a joint claim
11 construction and pre-hearing statement, complete claim construction discovery or file claim
12 construction briefs.

13 Equitable estoppel requires misleading conduct by the patentee, reliance and material
14 prejudice. There has been no discovery on these factual issues.

15 As this Court is aware and as defendant Rossignol has set forth in their summary
16 judgment brief “claims typically must be construed before determining whether or not they are
17 infringed or invalid and must be construed in the same way for both purposes.” . . .) Although
18 it is within the Court’s discretion as to when to construe the claims, the local rules have an
19 elaborate procedure to accomplish this function. Both parties have submitted several terms for
20 claim construction. At this point, claim construction in the context of the summary judgment
21 hearing would have to be done without sufficient evidence regarding same before the Court.
22 Claim construction at such an early stage in the proceedings may be premature. For example,
23 there has been no discovery on how the accused binding operates.

24 In *Fake Space Labs v. Robinson*, 2000 US Dist. LEXIS 17678 (N. Dist. Cal. 2000) the
25 Court held that motions for summary judgment for non-infringement and invalidity were
26 premature under the Northern District’s Local Patent Rules which contemplate that a Markman
27 hearing will precede motions for summary judgment. The Court took the motions for summary
28 judgment off calendar.

1 In the case of *Mc Nultey v. Taser Int'l, Inc.* 2002 US Dist. LEXIS 6810 (C. Dist. Cal.
2 2002) who presented with a motion for summary judgment on the issue for infringement, the
3 Court stated that the most thorough and expeditious course of action would be a Markman claim
4 interpretation hearing and that "because the Markman hearing may definitively resolve some of
5 the issues currently before the Court, plaintiff's motion for summary adjudication of
6 infringement is premature."

7 F.R.C.P. 56(f) states that a Court "may refuse an application for judgment or may order a
8 continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had
9 or may make such other order as is just." 56(f) permits the Court to deny a motion for summary
10 judgment if the opposing party has had insufficient time to conduct discovery. *Resolution Trust*
11 *Co. v. North Bridge Assocs.*, 22 F.3d 1198, 1203 (1st Cir. 1994).

12 The Ninth Circuit has definitively stated that "we generally disfavor summary judgment
13 where relevant evidence remains to be discovered." *Klinge v. Eikenberry*, 849 F.2d 409, 412
14 (9th Cir. 1988) reversing summary judgment because plaintiff was deprived of relevant
15 discovery.

16 In this case, all of the issues set forth in Rossignol's summary judgment motion
17 obviously involves facts which upon discovery should be conducted.

18
19 DATED: March 15, 2006

SEYFARTH SHAW LLP

20
21 By 

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